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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,818	10/20/1999	JAMES H. WANG	11302-0411	4641

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JOHN S. PRATT
KILPATRICK STOCKTON LLP (KIMBERLY CLARK)
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

EXAMINER

VO, HAI

ART UNIT

PAPER NUMBER

11

1771
DATE MAILED: 05/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/421,818	WANG ET AL.	
Examiner	Art Unit		
Hai Vo	1771		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 08 April 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1 and 3-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1 and 3-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

4) Interview Summary (PTO-413) Paper No(s) _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

1. Claims 2, and 21-42 have been cancelled in the amendment received on 04/10/2003.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 5-7,11, and 14-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,268,048. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

Claims 1-20 of U.S. Patent No. 6,268,048 reads on the claimed subject matter except an elongation property of a precursor film. However, it appears that the porous film of U.S. Patent No. 6,268,048 is formed from the same extrusion process and made of the same material such as a homogeneous blend of poly(ethylene oxide) and a particulate filler having the concentration within the same ranges, the pores formed around the particulate filler (claim 20) and a water vapor transmission rate meeting a specific range as required (claim 1), it is

the examiner's position that the elongation property would be inherently present within the range recited by the claims.

With regard to claims 19 and 20, claims 1-20 of U.S. Patent No. 6,268,048 does not specifically disclose a flushable article formed from the composition.

However, it has been held that a recitation with respect to the manner in which a claimed flushable article is intended to be employed does not differentiate the claimed flushable article from a prior art flushable film satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

4. Claims 8 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,268,048 in view of Wu et al (US 5,865,926). Claims 1-20 of U.S. Patent No. 6,268,048 do not specifically disclose the composition comprising a pore-forming filler such as a surface-treated calcium carbonate. Wu teaches a microporous composite including a pore-forming filler such as a surface-treated calcium carbonate having an average particle size of 0.5 to 5 microns within the same range (column 7, lines 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a surface-treated calcium carbonate as a pore-forming filler in the composition of U.S. Patent No. 6,268,048 motivated by the desire to assist the processability of the carbonate and produce a more hydrophobic filler product (Garcia, US 5,565,503, column 2, lines 47-50).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 7 and 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Callahan et al (US 6,057,061) in view of Radovanovic et al (US 6,096,213). Callahan discloses a microporous film being formed from a uniform blend of 63 volume % ethylene vinyl alcohol copolymer and 37 volume % particulate filler and by a particle stretch technique (example 1, column 2, lines 55-57). Callahan discloses the filler having a particle size ranging from 0.4 to 0.8 microns which is anticipatory of the claims. Callahan discloses the film having a thickness of 10 mils (column 4, lines 18-19). Callahan further discloses the film having a thickness of 5 to 200 microns (0.2 to 7.9 mils). The thickness range of claim 13 overlaps with the value disclosed in Callahan. Callahan is silent as to a microporous film comprising poly(ethylene oxide). Radovanovic discloses a microporous membrane formed from poly(ethylene oxide) to impart a high biaxial orientation ratio in a manner that enhances its mechanical integrity (column 4, lines 6-10, and 25-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace ethylene vinyl alcohol copolymer by poly(ethylene oxide) to form a microporous film of Callahan

motivated by the desire to impart a high biaxial orientation ratio in a manner that enhances its mechanical integrity.

It appears that Callahan as modified by Radovanovic is using the same materials and the same extrusion to form a microporous film as Applicant, it is the examiner's position that the elongation properties would be inherently present within the range as set forth in the claims. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete (Note discussion found in Ex parte Slob, 157 USPQ 172).

Response to Arguments

7. Applicant's arguments with respect to claims 1, and 3-20 have been considered but are moot in view of the new ground(s) of rejection.
8. The art rejections in Paper no. 6 have been overcome by the present amendment and response.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
US 5,565,503 to Garcia et al is directed to a polyolefin film comprising an inorganic carbonate having a surface treated with organic acids to assist the processability of the carbonate and produce a more hydrophobic filler product.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-

4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
April 22, 2003



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700